Remarks

Reconsideration of this application is requested. Claims 1, 11, 19 and 24 have been amended. Claims 1-28 remain in the application.

Objection to Claim 8

The Office Action states that claim 8 was objected to because of informalities that indicate "wheein" should be "wherein." This error does not appear on our copy of the stored document, but Applicant agrees that this change should be made as indicated by the Examiner.

Response to the 35 U.S.C. §103(a) Rejection

The Office Action rejects claims 1, 4-6, 11-12, 16, 19-20 and 24-25 under 35 U.S.C. 103(a) as being unpatentable over Laurila et al. (U.S. 6,591,116) in view of Back (WO 2001/11911).

Rejection of claims 1, 4-6

Applicants' claim 1 recites, among other things, a mobile communication device adapted to permit a first wireless network to update information used to modify the classmark and alter how the mobile communication device interacts with a second wireless network with the communication module.

Laurila et al. teach a mobile communication device having a process and a communication module. SIM and USIM applications are shown having different capabilities that allow operation in two different types of networks and roaming between those two networks. Laurila et al. teach in column 7, lines 56-59, that should a roaming agreement be in place between two networks, then both networks may request and receive the capability of its own or the others application(s). The Examiner states that Laurila fails to disclose "a first wireless network to modify the classmark to alter how the mobile communication device interacts with a second wireless network with the communication module." The Examiner then states that Back provides this teaching.

Therefore, a closer look at Back et al. shows that a user terminal stores capability data (classmark information) indicative of the user terminal's capabilities for communication with the service subsystems and the access subsystems. Such teachings are found on at least page 4, lines 25-27; page 5, lines 9-12; page 5, lines 21-23; page 6, lines 5-8; page 7, lines 23-25 and 27-30. Then, on page 11, lines 16-

23, Back et al. provide an example of a handover event from a first wireless network to a second, different wireless network. Back et al. state in lines 25-28 that a measurement of signal quality or other parameters may decide the handover from the UMTS to the GSM system.

In the handover example provided on page 11, Back et al. teach that the first wireless network (the UMTS) sends a classmark enquiry message (at 64, FIG. 4) to the user equipment (UE). The UE may respond with capability data indicative of the user terminal's capabilities for communication, or alternatively knowing that a handover may occur, respond with a classmark change message (at 65) to provide the classmark information for the second wireless network (the GSM). When the second wireless network is aware of the UE classmark information for GSM, the system handover may then take place (at 67).

In essence, the UE has a classmark storing capability data indicative of the user's capabilities for communication with either of two networks. As taught by Back et al., either network may send a classmark enquiry message to the UE. In one instance, the UE responds by providing the requested classmark information for that network. In the other instance, the UE responds with the classmark information for the other network, knowing that a handover is imminent. However, Back et al. does not teach or suggest that a network may update information to a mobile communication device that is used to modify the stored classmark.

The classmark in the Back et al. device simply stores capability data indicative of the user's capabilities for the two networks, and then provides that stored data in response to a request from the network. For Back et al. the classmark data is not updated, and certainly that classmark data does not alter how the mobile communication device interacts with a second wireless network.

Thus, the teaching of Back et al. and Laurila et al., either taken singularly or in combination, do not teach these features of Applicant's amended claim 1, namely, that a first wireless network updates information used to modify the classmark and alter how the mobile communication device interacts with a second wireless network with the communication module. Accordingly, the relied upon art does not teach or suggest Applicant's claim 1 and the rejection under 35 U.S.C. 103(a) should be withdrawn.

Rejected claims 4-6 depend directly from base claim 1 and are believed allowable for at least the same reasons as Applicant's claim 1.

Rejection of claims 11, 12 and 16

Applicant's claim 11 recites a method of interacting with a first network and a second network with a portable communication device. Data is sent from the first network to modify a classmark of the portable communication device.

Again, Back et al. teach that the first wireless network (the UMTS) sends a classmark enquiry message and the UE responds with capability data indicative of the user terminal's capabilities for communication. Whereas Back et al. teach that a classmark enquiry message is sent by the network, in contrast, Applicant's claim 11 recites that data is sent from the first network to modify a classmark of the portable communication device. As previously mentioned, neither Back et al. nor Laurila et al., either taken singularly or in combination, teach that data is sent from the first network to modify a classmark of the portable communication device. Accordingly, the relied upon art does not teach or suggest Applicant's claim 11 and the rejection under 35 U.S.C. 103(a) should be withdrawn.

Rejected claims 12 and 16 depend directly from base claim 11 and are believed allowable for at least the same reasons as Applicant's claim 11.

Rejection of claims 19-20

Applicant's claim 19 recites, among other things, sending data from the first network to update and modify the classmark of the portable communication device.

In Laurila et al. and Back et al. communication systems, a network may send a classmark enquiry message to the user equipment, but neither reference teaches that data is sent from the first network to update and modify the classmark of the portable communication device. Applicant would like to emphasize that the preceding was not intended to attack Laurila et al. and Back et al. separately. But instead, Applicant would like to respectfully point out how each is devoid of claimed elements so that, by default, the combination is also devoid of at least some of the features of Applicant's claimed invention.

Since claim 20 depends from claim 19, Applicant believes the rejection of claim 20 has been overcome for at least the same reason.

Rejection of claims 24-25

Applicant's claim 24 recites, among other things, polling a portable communication device from a first network to determine the classmark of the

portable device, and initiating a process to update and modify the classmark of the portable communication device with a command from the first network.

Applicant's claim 24 includes the first network initiating a process to update and modify the classmark of the portable communication device. At least this feature of Applicant's claim 24 is not found in either of the Laurila et al. and/or Back et al. references, and therefore, Applicant believes the rejection of claim 24 should be withdrawn.

Rejection of claims 2-3

The Office Action rejects claims 2-3 under 35 U.S.C. 103(a) as being unpatentable over Laurila et al. (U.S. 6,591,116) and Back (WO 2001/11911), further in view of Rousseau et al.

Claims 2-3 depend, either directly or indirectly, from Applicant's claim 1 and are believed to be allowable for at least the same reasons as claim 1.

Rejection of claims 7-8, 13-15, 22-23 and 27-28

The Office Action rejects claims 7-8, 13-15, 22-23 and 27-28 under 35 U.S.C. 103(a) as being unpatentable over Laurila et al. (U.S. 6,591,116) and Back (WO 2001/11911), further in view of Vestergaard et al.

Claims 7-8 depend from Applicant's claim 1 and are believed to be allowable for at least the same reasons as claim 1.

Claims 13-15 depend from Applicant's claim 11 and are believed to be allowable for at least the same reasons as claim 11.

Claims 22-23 depend from Applicant's claim 19 and are believed to be allowable for at least the same reasons as claim 19.

Claims 27-28 depend from Applicant's claim 24 and are believed to be allowable for at least the same reasons as claim 24.

Rejection of claims 9-10, 21 and 26

The Office Action rejects claims 9-10, 21 and 26 under 35 U.S.C. 103(a) as being unpatentable over Laurila et al. (U.S. 6,591,116) and Back (WO 2001/11911), further in view of Roe-Ng et al.

Claims 9-10 depend from Applicant's claim 1 and are believed to be allowable for at least the same reasons as claim 1.

Claim 21 depends from Applicant's claim 19 and is believed to be allowable for at least the same reasons as claim 19.

Claim 26 depends from Applicant's claim 24 and is believed to be allowable for at least the same reasons as claim 24.

Rejection of claims 17-18

The Office Action rejects claims 17-18 under 35 U.S.C. 103(a) as being unpatentable over Laurila et al. (U.S. 6,591,116) and Back (WO 2001/11911), further in view of Rosenberg et al.

Claims 17-18 depend, either directly or indirectly, from Applicant's claim 11 and are believed to be allowable for at least the same reasons as claim 11.

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed August 17, 2004, and it is submitted that claims 1-28 are in condition for allowance. Reconsideration of the rejection of claims is requested and the allowance of amended claims is earnestly solicited.

Should it be determined that a fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #50-0221.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 715-5388 is respectfully solicited.

Respectfully submitted,
Matthew A. Hayduk

Lanny L. Parker

Lanny L. Parker
Patent Agent
Reg. No. 44,281

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026
(503) 264-0967